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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,076	03/18/2000	Geoffrey B. Rhoads	60131	5497

23735 7590 03/17/2004

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 250  
TUALATIN, OR 97062

EXAMINER

ZIA, SYED

ART UNIT PAPER NUMBER

2131

DATE MAILED: 03/17/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/531,076

Applicant(s)

RHOADS ET AL.

Examiner

Syed Zia

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 17-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                        |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed on January 12, 2003 (Paper No. 7). Original application contained Claims 1-16. Applicant canceled Claims 6-16, and left unchanged Claims 1-5. Applicant added new Claims 17-22. The amendment filed have been entered and made of record. Presently pending claims are 1-5, and 17-22.

### ***Response to Arguments***

1. Applicant's arguments with respect to claim 1-5, and 17-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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2. Claim 1-5, and 17-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Shinoda et al. (US Patent 6,611,830), and further in view of Durst et al. (U. S. Patent 6,108,656).

3. Regarding Claim 1, 2, 3, and 17 Shinoda teaches and describes digital watermarking method comprising:

- in response, at said second device, identifying address information corresponding to said first object identifier and sending same to the first device (col.3 line 51 to col.4 line 15);

- identifying additional address information corresponding to said additional objects; and sending said additional address information to the first device (col.5 line 48 to col.6 line 25, and col.6 line 29 to line 47);

- storing said additional address information in a memory at the first device; wherein, if an object included among said identified additional objects is sensed by the first device, the corresponding address information can be retrieved from said memory in the first device without the intervening delays of communicating with the second device (col.7 line 43 to col.8 line 35).

- a database method comprising: generating a database record including plural data fields, generating a file corresponding to said database record and including data from at least certain of said fields, electronically distributing a copy of the file to each of plural recipients, one of said recipients adding data to a copy of the file, or changing data in a copy of the file, and sending the file to the database; updating the database record in accordance with said changed file, generating a new file corresponding to the updated database record and including data from at least certain of said fields; and electronically distributing a copy of the new file to each of said plural recipients (col.5 line 48 to col.6 line 64).

- linking from physical or digital objects to corresponding digital resources, comprising: registration means for receiving data relating to an object, including its identity and owner, and associating same in a database with data relating to a corresponding response, originating device means for sensing data from an input object, processing same, and forwarding same to a routing means; routing means for processing the processed data from the originating device means, logging information from same, and forwarding at least certain of said processed data to a product handler means; an product handler means for providing a response to the originating device means in accordance with the information provided thereto by the routing means (col. 4 line 17 to line 63).

Shinoda does not explicitly teach identifying, and initiating a link using a machine-readable device. However, Durst teaches and describes a mean to access electronic information through machine-readable codes on printed documents (Summary), wherein:

4 sensing an object identifier from a first object; sending said first object identifier from a first device to a second device (Fig.1, col.5 line 24 to line 52)

- initiating a link from the first device in accordance with said address information (col.4 line 46 to col.5 line 11);

- at said second device, identifying additional objects related to said first object (col.5 line 53 to col.6line 2); and

- linking physical objects to corresponding electronic resources, the method including decoding object payload data from a machine readable feature associated with a physical object, querying a database with at least some of said payload data to obtain address information

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associated with said physical object, and establishing an electronic link based on said obtained address information, an improvement comprising foreseeing information about object payloads that may be forthcoming, and anticipatory sending address information associated with such foreseen payloads(col.4 line 46 to col.5 line 52).

Therefore, it would be obvious for one with ordinary skill in the art at the time the invention was made to employ teachings of Durst within the system of Shinoda to provide a mechanism to read machine-readable (such as scanner, or barcode reader) symbol comprising encoded source data, application launch information as well as file location information, because this will provide another interface of data connection for transmitting information between at least a first communication device and a second communication device.

4. Claims 4,5, 18, 19, 20, 21, and 22 are rejected applied as above rejecting Claims 3, and 17. Furthermore, system of Shinoda and Durst teaches and describes a system and method wherein

- the routing means includes means for checking information in the database (Shinoda: col.8 line 18 to line 35);

- the registration means includes means for generating an encapsulating file and means for distributing said file to predetermined parties (Shinoda col.6 line 14 to line 29, and col.7line 44 to line 61);

- the physical object is a member of a logical set, and the method includes anticipatorily sending address information associated with other objects that are also member of said logical set (Shinoda col.6 line 14 to line 29, and col.7line 44 to line 61);

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- the logical set comprises of advertisements found in particular magazine (Durst col.5 line 15 to line 23);

- foreseeing an order in which other object payloads may be forthcoming, and anticipatorily sending address information for each object payloads in said order (Shinoda col.6 line 14 to line 41);

- said order is based on an order of printed pages in a bound volume (Durst: col.5 line 53 to line 61);

- determining an order in which to send address information associated with said foreseen object based on a contractual arrangement (Shinoda col.6 line 14 to line 29, and col.7line 44 to line 61).

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SZ

March 11, 2003

  
AYAZ SHEIKH  
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